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09/30/2003

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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/674,862
Filing Date: September 30, 2003
Appellant(s): BALL, WILLIAM T.

Craig W. Mueller
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 12, 2008
appealing from the Office action mailed May 01, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The related appeals noted at pages 4-5 of the brief are known to the examiner.

Re appeal A, the previously allowed claims were rejected in light of newly discovered prior art to Oropallo et al. '875.

Re appeal B, the notice of allowance was issued in light of the 35 USC 120 benefit claim perfected June 27, 2006, just before filing of the brief on July 03, 2006. The perfected benefit claim removed the outstanding grounds of rejection (Final Rejection, March 27, 2006).

Re appeal C, prosecution was reopened in light of newly discovered prior art to Oropallo et al. '875.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment after final rejection filed on August 01, 2007 has been entered, obviating a specification objection.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejection of claim 26 under 112, second paragraph, is hereby withdrawn in light of the argument at page 14 of the brief.

GROUND OF REJECTION NOT ON REVIEW

The following grounds of rejection have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review in the appellant's brief. Claims 26-30, 12 and 15-17 as being unpatentable under 35 USC 103 over Gebert and Lewis.

The appellant's statement of the grounds of rejection B-I to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,618,875	Oropallo et al.	09/2003
6,192,531	Fritz et al.	02/2001
5,350,266	Espey et al.	09/1994
CH 346,187	Gebert	06/1960
2002/0032926	Lewis	03/2002

English language translation of CH 346,187 (originally cited in application no. 10/229,533, copy attached hereto)

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims (designations as provided by appellant):

B. Claims 20-23 and 33-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Oropallo et al.

The Oropallo et al. (Oropallo) reference discloses an overflow system comprising: an overflow conduit/pipe 11 including a flange (at 12) and threads 22; a fastening member/nut 21 including a lug 24 and threads 23; a cap 10 including a flange 10a and a notch 50; and a closure device/member 40, as claimed.

Appellant argues at pages 14-16 of the brief the Rule 131 declaration filed March 13, 2007 (duplicated April 05, 2007) removes Oropallo as a prior art reference. The examiner disagrees. The abandoned application serial no. 09/593,724 ('724), at best, serves as evidence of conception. And, a proper Rule 131 declaration must also include a showing of diligence. See MPEP 2136.05. Appellant merely states at section 5 in the Rule 131 declaration that he has "been diligent in seeking patent protection" as evidenced by the filing of the '724 application, as well as the filing of applications 10/229,533 ('533) and 10/222,062. However, the instant application does not enjoy a 35 USC 120 filing date benefit from the '724 application. According to the USPTO PALM records, the '724 application became abandoned on June 17, 2002 (contrary to the October 15, 2002 date alleged in the declaration). The intervening '533 application was not filed until August 28, 2002. Therefore, no copendency was established between the '724 and '533 applications as required by 37 CFR 1.78. Appellant has not shown reasonable diligence. Indeed, as discussed in the MPEP section noted supra, "a prior application which was not copending with the application at issue cannot be used to antedate a reference." Appellant's reliance on Naber v. Cricchi at page 15 of the brief is not understood. Naber involved

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diligence in an interference proceeding. There is no rejection tendered under 35 USC 102(g) in the instant application.

Further in this regard, the rejection tendered under 35 USC 102(e) is not the only rejection of the pending claims (MPEP 706.02(b)).

C. Claims 20-22 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Espey et al.

The Espey et al (Espey) reference discloses a conduit/pipe 12 including a flange (Fig. 3) and threads 13; a fastening member/nut 20 including a lug 21 and threads 31; and a cap 40 including a flange 41-46 and a notch (receiving 14), as claimed. The initial statement of intended use (overflow system, bathtub, etc.), and all other functional implications related thereto ("adapted to be positioned at least partially with in the bathtub", etc.), have been considered but do not appear to impose any patentably distinguishing structure over that disclosed by Espey.

Appellant argues at pages 16-18 of the brief Espey does not disclose the claimed lugs and frictional engagement. The examiner disagrees. Interpreting the claim language broadly, the projections 52 and slots 33 of Espey are at least to some degree frictionally engaged, and clearly are detachable as acknowledged by appellant at page 18 (even if a removal tool is

required). Appellant's reliance on extrinsic evidence (dictionary) to give the claim term "frictionally detachably engage(ment)" a special meaning is neither appropriate nor necessary. The actual structure of the claimed device is clearly depicted in Fig. 4 (09/30/03) of the instant application, which enables a reader to easily ascertain the meaning of the noted language. The structure in Espey is at least equivalent to the structure disclosed by appellant.

D. Claims 20-22 and 33-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Gebert.

The Gebert reference discloses an overflow system comprising: an overflow conduit/pipe 1 including a flange 5 and threads 4; a fastening member/nut 8 including a lug 11 and threads (engaging 4); and a cap 14 including a flange (at 16) and a notch 15, as claimed.

Appellant argues at page 19 of the brief Gebert discloses a plate that receives the cap. The examiner agrees, and notes such subject matter clearly anticipates the broad claim language. In this regard, the nut 8 in Gebert "includes an outer periphery (10) with a radially extending lug (11)" (language of claim 21, numerals added). The terms "includes" (claim 20) and "having" (claim 33) do not appear to establish the claimed nut and lug as a single piece as portrayed by

appellant. Furthermore, even though the terms of claims 20 and 33 are met by only one lug, Gebert contemplates a plurality thereof as disclosed in the second full paragraph on page 4 of the English language translation (attached hereto).

E. Claims 23-25 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oropallo and Fritz et al.

Although the closure device/member of the Oropallo overflow system does not include a diaphragm, as claimed, attention is directed to the Fritz et al. (Fritz) reference which discloses an analogous overflow system which further includes a closure device/member in the form of a diaphragm 15. Therefore, in consideration of Fritz, it would have been obvious to one of ordinary skill in the closure device/member art to associate a diaphragm with the Oropallo overflow system in order to enable molding the closure device/member in place (col. 1 lns. 49-52).

Appellant has not substantively argued this ground of rejection beyond noting claim dependency.

F. Claims 26-31, 12 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oropallo and Lewis.

Although the duct (conduit/pipe) of the Oropallo overflow system does not include a fitting, as claimed, attention is directed to the Lewis reference (Fig. 4) which discloses an analogous overflow system which further includes a duct 19

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having a fitting 41. Therefore, in consideration of Lewis, it would have been obvious to one of ordinary skill in the overflow system art to associate a fitting with the Oropallo duct in order to enable separate manufacture (par. 0020 lns. 7-10).

Appellant has not substantively argued this ground of rejection beyond noting his belief that Oropallo is not prior art to the instant application.

G. Claims 31, 32, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oropallo and Lewis as applied to claims 26 and 12 above, and further in view of Fritz.

To associate a diaphragm with the Oropallo overflow system would have been obvious to one of ordinary skill in the art in consideration of Fritz analogous to the discussion supra.

Appellant has not substantively argued this ground of rejection beyond noting claim dependency.

H. Claims 23-25 and 37-39 rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Fritz.

To associate a diaphragm with the Gebert overflow system would have been obvious to one of ordinary skill in the art in consideration of Fritz analogous to the discussion supra.

Appellant has not substantively argued this ground of rejection beyond noting claim dependency.

Grounds of rejection not on review: Claims 26-30, 12 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Lewis. To associate a fitting with the Gebert duct would have been obvious to one of ordinary skill in the art in consideration of Lewis analogous to the discussion supra.

I. Claims 31, 32, 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gebert and Lewis as applied to claims 26 and 12 above (*italics*), and further in view of Fritz.

To associate a diaphragm with the Gebert overflow system would have been obvious to one of ordinary skill in the art in consideration of Fritz analogous to the discussion supra.

Appellant has not substantively argued this ground of rejection beyond noting claim dependency.

(10) Response to Argument

Appellant's remaining remarks have been fully considered and either have been previously addressed or are not deemed persuasive in view of the prior art as specifically applied in light of the level of skill in the pertinent art.

(11) Evidence Appendix

The English language translation of CH 346,187 is attached hereto.

(12) Related Proceedings Appendix

Copies of the court or Board decision(s) identified in the Related Appeals and Interferences section of this examiner's answer are provided in the brief (Appeal 2007-0769).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Robert M. Fetsuga/
Robert M. Fetsuga

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TC 3700 TQAS